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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,157	03/18/2004	John Walter Liebeschuetz	X14659B	6498

25885 7590 06/21/2006

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EXAMINER

HABTE, KAHSA Y

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/803,157	Applicant(s) LIEBESCHUETZ ET AL.	
	Examiner Kahsay Habte	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-46 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 36-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 36-46 are pending in this application.
2. Upon further review of this case, it is deemed necessary to vacate the earlier restriction requirement. Thus, this restriction replaces the earlier restriction requirement.

Note that applicants have elected a single species on 5/22/2006 for examination, but argue the earlier restriction requirement, "In the absence of clear restriction requirement in the instant application, applicants do not wish to delete subject matter from the claims". Thus, this restriction was made to clarify the groups and to be consistent with the restriction requirement made in the parent.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 36 (in part), 38 (in part) and 40-46 (in part), drawn to Cy = pyrimidinyl, classified in class 544, subclass various.
 - II. Claims 36 (in part), 38 (in part) and 40-46 (in part), drawn to Cy = pyridinyl or piperidinyl, classified in classes 544 and 546, subclass various.
 - III. Claims 36 (in part), 38 (in part) and 40-46 (in part), drawn to Cy = thiadiazolyl, classified in classes 544 and 548, subclass various.

Art Unit: 1624

- IV. Claims 36 (in part), 38 (in part) and 40-46 (in part), drawn to Cy = pyrazolyl or imidazolyl, classified in classes 544 and 548, subclass various.
- V. Claims 36 (in part), 38 (in part) and 40-46 (in part), drawn to Cy = oxazolyl or thiazolyl, classified in classes 544 and 548, subclass various.
- VI. Claims 36 (in part), 38 (in part) and 40-46 (in part), drawn to Cy = furan or thienyl, classified in classes 544 and 549, subclass various.
- VII. Claims 36 (in part), 38 (in part) and 40-46 (in part), drawn to Cy = pyrrolyl, classified in class 544 and 548, subclass various.
- VIII. Claims 36 (in part), 37, 38 (in part), 39 and 40-46 (in part), drawn to Cy = phenyl, classified in class various 544 and 564, subclass various.
- IX. Claims 36 (in part), 38 (in part) and 40-46 (in part), drawn to Cy = others, classified in class 544, 546, 548 or 549, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Groups I-IX are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of **Cy** in the compound formula do not belong to the same recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others. Group I is drawn to pyrimidinyl ring (six-membered ring with 2 nitrogens at 1,3 position) and is different from Groups II-IX. Group II is drawn to pyridinyl ring (6-membered ring with one nitrogen) and is different from Group I or Groups III-IX. Group III is drawn to thiadiazolyl ring (5-

Art Unit: 1624

membered ring with 2 nitrogens and sulfur) and is different from Groups I-II or Groups IV-IX. Like wise, Groups IV-IX are different one from the other. Each group comprises a different heterocyclic core system. Group IX is drawn to compounds that don't fall in Groups I-VIII. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structure equivalents of each other.

Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

If applicants elected Group IX, a tentative election of species is required.

A telephone call was made to Mr. Thomas Jackson on June 1, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Art Unit: 1624

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte
Primary Examiner
Art Unit 1624

June 9, 2006